

REMARKS***Summary of the Response***

By the present response, claims 18 and 27 will have been amended, claim 26 will have been canceled without prejudice or disclaimer, and new claim 43 will have been entered for consideration by the Examiner. Accordingly, while claims 18 – 25, 27, 28 and 30 – 43 are now pending, claims 39 – 42, directed to the non-elected invention, have been withdrawn from consideration by the Examiner as being drawn to a non-elected invention. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Summary of the Office Action

In the instant Office Action, the Examiner has rejected claims 18 – 28 and 30 – 38 based upon formal matters and has rejected these claims based upon formal matters and over the art of record. By the present amendment and remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Acknowledgment of Interview with Examiner Halpern

Applicants gratefully acknowledge the courtesy extended to their representative by Examiner Halpern in conducting a personal interview on March 5, 2010. In the interview, the undersigned identified distinctions between the applied art and the pending claims, but the Examiner suggested amending the claims with the subject matter of claim 26. The undersigned further proposed an amendment to include subject matter described beginning on line 24 of page

24 of the specification. Further, Applicants suggested language to address the formal rejections, which the Examiner indicated he would consider upon submission of this response.

By the present amendment, Applicants have amended claim 1 to address the formal matters and to include the subject matter suggested by the Examiner, and have presented a new independent claim that recites the subject matter described on page 24 of the disclosure.

Rejection Under 35 U.S.C. § 112, First Paragraph, is Moot

Applicants submit that the formal rejection of claims 18 – 28 and 30 – 38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is moot.

While Applicants do not agree that the original disclosure does not reasonably convey to one ordinarily skilled in the art that the inventors had possession of the invention including the recited coating color distribution chamber at the time the application was filed, in an effort to advance prosecution, Applicants have amended independent claim 18 to change the term “coating color distribution chamber” to “coating color supply.”

Applicants further note that, while the film press and spray coating embodiments of the color coating applicator nozzle only show nozzles 61, 62 (Fig. 4) and 66, 67 (Fig. 5), it would have been readily apparent to one ordinarily skilled in the art that these nozzles are connected to some sort of coating color supply unit. Thus, Applicants submit that one ordinarily skilled in the art reviewing the original disclosure would readily understand that the nozzles for the film press illustrated in Fig. 4 are connected to some sort of coating color supply unit, such that the recited features in at least independent claim 18 are fully supported by the original disclosure.

As it would have been apparent to the ordinarily skilled artisan at the time the invention was made that the original disclosure provides implicit support for reciting a coating color supply

to supply coating color to a nozzle, Applicants submit that the original disclosure reasonably conveys to one ordinarily skilled in the art that Applicants had possession of a color coating supply in combination with the film press, as now recited in at least independent claim 18, at the time this application was filed.

Accordingly, Applicants request that the Examiner reconsider and withdraw the formal rejection of claims 18 – 28 and 30 – 38 under 35 U.S.C. § 112, first paragraph, and indicate that these claims are fully in compliance with the requirements of the statute.

Rejection Under 35 U.S.C. § 112, Second Paragraph, is Moot

Applicants submit that the formal rejection of claims 18 – 28 and 30 – 38 under 35 U.S.C. § 112, second paragraph, as being indefinite is moot.

While Applicants do not agree that the term coating color distribution chamber is unclear or that one ordinarily skilled in the art would not be able to understand the metes and bounds of the claims using the term coating color distribution chamber, in an effort to advance prosecution, Applicants have amended independent claim 18 to change the term “coating color distribution chamber” to “coating color supply.”

For the reasons set forth above, Applicants note that one ordinarily skilled in the art reviewing the original disclosure would understand that the film press nozzles 61, 62 illustrated in Fig. 4 are connected to a coating color supply that supplies the coating color to the nozzles. Thus, Applicants submit that one ordinarily skilled in the art reviewing the original disclosure would readily understand that the nozzles for the film press illustrated in Fig. 4 are connected to some sort of coating color supply unit, such that the recited features in at least independent claim 18 are fully supported by the original disclosure.

As it would have been apparent to the ordinarily skilled artisan at the time the invention was made that the original disclosure provides implicit support for reciting a coating color supply to supply coating color to a nozzle, Applicants submit that one ordinarily skilled in the art reviewing the original disclosure and claims would readily understand the claim term “coating color supply” so as to be able to ascertain the scope of the pending claims without undue experimentation.

Accordingly, Applicants request that the Examiner reconsider and withdraw the formal rejection of claims 18 – 28 and 30 – 38 under 35 U.S.C. § 112, second paragraph, and indicate that these claims are fully in compliance with the requirements of the statute.

Traversal of Rejection Under 35 U.S.C. § 103(a)

1. Over Ahonen

Applicants submit the rejection of claims 18 – 23 under 35 U.S.C. § 103(a) as being unpatentable over AHONEN et al. (U.S. Patent 6,413,371) [hereinafter “AHONEN”] is moot. Applicants traverse, *inter alia*, the Examiner’s assertion that AHONEN discloses a film press to apply a color coating 500.

While Applicants do not acquiesce that the subject matter of claims 18 – 23 as previously presented is rendered unpatentable under any proper interpretation and modification of AHONEN under 35 U.S.C. § 103(a), in an effort to advance prosecution, Applicants have amended independent claim 18 to include the subject matter of now canceled claim 26. Because the Examiner’s rejection does not allege that AHONEN alone teaches or suggests the subject matter recited in previously presented claim 26, Applicants submit that the pending rejection is moot.

Accordingly, for at least the above reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 18 – 25, 28, and 30 – 38 under 35 U.S.C. § 103(a) and indicate that these claims are allowable.

2. Over Ahonen in view of Meschenmoser

Applicants traverse the rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over AHONEN in view of MESCHENMOSER (U.S. Patent 6,406,596).

With regard to the pending rejection of the claims under 35 U.S.C. § 103(a), Applicants note the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, Applicants are under no obligation to submit evidence of non-obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) there must be a reasonable expectation of success; and
- (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP §2142.

Further, while rejecting a *rigid* application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the U.S. Supreme Court acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field

to combine the elements in the way the claimed new invention does” in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).

Applicants’ independent claim 18 recites, *inter alia*, a pressing section comprising a tandem press composed of two shoe press rolls and counter rolls, and an additional third press, a coating color supply, and a film press having at least one film roll structured and arranged to apply a coating color supplied by the coating color supply, such that the coating color has a solids proportion of less than 65% measured in percent by mass. Applicants submit that no proper combination of AHONEN in view of MESCHENMOSER render obvious the above-noted features of Applicants’ invention. As claim 26 has been canceled without prejudice or disclaimer, Applicants submit that the rejection of at least claim 26 is now moot.

Applicants agree with the Examiner that AHONEN fails to disclose or even suggest a pressing section that includes a tandem press composed of two shoe press rolls and counter rolls, and an additional third press, as now recited in at least independent claim 18. Moreover, Applicants submit that the term coating color is absent from the disclosure of AHONEN. Instead, AHONEN discloses a film size press to apply a coating 500 (not a coating color). In fact, Applicants submit that, as AHONEN fails to disclose applying a coating color to the web, one ordinarily skilled in the art would not reasonably expect to achieve the features of the present invention through any obvious modification of AHONEN under 35 U.S.C. § 103(a).

As described by AHONEN, the invention concerns the manufacture of paper “for color powder printing.” [AHONEN, Abstract, ll. 1 – 3]. Further, the background discussion in AHONEN provides that “[o]ne important need is glossy porous paper, which is well suited for

colour-powder based printing” [AHONEN, col. 1, ll. 21 – 23], and that “[o]ne problem in printing with a colour copier is inadequate gloss of the paper to be used.” [AHONEN, col. 1, ll. 30 – 32]. AHONEN summarizes that “in colour-powder printing, such a coated or compacted paper is needed as does not adhere to the colour powder fixing unit and in whose use said problem of glass-sheet effect does not occur.” [AHONEN, col. 1, ll. 37 – 40].

Thus, in contrast to the instant invention, which is directed to applying a coating color onto the surface of a web as part of the manufacture of the web, AHONEN is directed to a machine for manufacturing a paper onto the finished product of which a color powder from a color copier will be applied. In other words, the web according to Applicants’ invention has a coating color applied during the manufacturing process, while the post manufactured, i.e., finished product of AHONEN will receive color toner when used in a color copier.

While the finished product of AHONEN, i.e., color copier paper (where “color” refers to the copier not the paper), is intended to receive color powder (i.e., toner) in a printing process within a color copier, AHONEN fails to provide any express or implied disclosure of applying a coating color via film press 500 or any other structure or process within the disclose manufacturing process of AHONEN. Further, while the Examiner has asserted AHONEN discloses coating color, the Examiner has not identified any subject matter in AHONEN in support of his assertion.

In this regard, AHONEN discloses a film size press 500 to provide a coating agent onto the face of the paper web. [AHONEN, col. 6, ll. 51 – 55]. However, rather than disclosing that this coating agent is a *coating color*, as recited in the pending claims, AHONEN merely discloses that the coating agent is applied to provide the best porosity. [AHONEN, col. 6, ll. 56

– 64]. There is no apparent or suggested disclosure of coating color, as recited in at least Applicants' independent claim 18.

To address the noted deficiency of AHONEN with regard to the press section including a tandem press composed of two shoe press rolls and counter rolls, and an additional third press, the Examiner has applied MESCHENMOSER. However, Applicants submit that, not only does MESCHENMOSER fail to provide any express or implied teaching for modifying AHONEN to include a tandem press composed of two shoe press rolls and counter rolls, and an additional third press, but also fails to teach or suggest modifying AHONEN to apply a coating color to the web. That is, while MESCHENMOSER discloses an offset press, the Examiner has not identified any articulated reasoning found in the applied art for modify AHONEN to include this third press in combination with the two presses disclosed by AHONEN.

Thus, Applicants submit that the Examiner has not identified any teaching in the art to suggest why one ordinarily skilled in the art would modify AHONEN in the manner suggested by the Examiner. Further, as it not apparent from AHONEN that further pressing of the web would enhance the operation of the AHONEN, Applicants submit that the Examiner has not shown any teaching that would suggest that one ordinarily skilled in the art would expect to achieve a successful result from the alleged modification of AHONEN in view of MESCHENMOSER.

Further, Applicants submit that MESCHENMOSER fails to disclose or suggest applying a coating color to the web. Accordingly, Applicants submit that the Examiner has failed to identify any articulated reasoning as to why one ordinarily would expect Applicants' invention to result from an obvious combination of AHONEN in view of MESCHENMOSER.

Thus, Applicants submit that no proper combination of AHONEN and MESCHENMOSER can render unpatentable the combination of features recited in at least independent claim 18, as currently presented, such that the pending rejection should be reconsidered and withdrawn.

Further, Applicant respectfully submits that claim 27 is allowable at least for the reason that it depends from an allowable independent claim, and because it recites additional subject matter to further defines the instant invention.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 27 under 35 U.S.C. § 103(a) and indicate that claim 27 is allowable.

Complete Action Not Provided

Applicants respectfully submit that the Examiner did not provide a complete action, and as such, Applicants submit that the next action should not be a final action. As set forth above, Applicants submit that with regard to claims 23 and 31 – 35, the Examiner has not addressed any of the features of these claims, and with regard to claims 22 and 36, the Examiner has not properly addressed each of the features as recited.

Thus, Applicants submit that a clear record was not provided and a clear issue was not developed between Applicants and the Examiner. More specifically, MPEP §706 states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicants respectfully request that the Examiner properly address the features of claims 22, 23 and 31 – 36, such that a clear issue is developed between the Examiner and Applicants. Moreover, Applicants respectfully submit that the next action, which should clarify the record, cannot be a final action.

New Claim is Allowable

Applicants submit that newly presented independent claim 43 is allowable over the art of record. Applicants note that new claim 43 is generally based on independent claim 18, as previously presented, and additionally recites a metering rod structured and arranged to doctor off excess coating color and to calibrate a thickness of the web. As Applicants have previously noted, neither AHONEN nor MESCHMOSER disclose applying a coating color to the web. As such, Applicants submit that no proper combination of these documents can render obvious the combination of features recited in at least new claim 43.

Further, Applicants note that neither AHONEN nor MESCHENMOSER expressly or impliedly disclose a metering rod structured and arranged to doctor off excess coating color and to calibrate a thickness of the web. That is, Applicants note that there is no disclosure that the coating applied by the size press of AHONEN is doctored off by a metering rod in order to

calibrate the thickness of the web, as recited in at least independent claim 43. Further, MESCHMOSER is entirely silent with regard to any such disclosure.

As the applied art fails to expressly or impliedly disclose the above-noted features of at least independent claim 43, Applicants submit that no proper combination of AHONEN in view of MESCHENMOSER under 35 U.S.C. § 103(a) can render obvious the embodiment of the invention recited in at least claim 43. Accordingly, Applicants request that the Examiner consider the merits of newly submitted claim 43 and indicate the allowance of the same in the next official communication.

Authorization to Charge Deposit Account

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

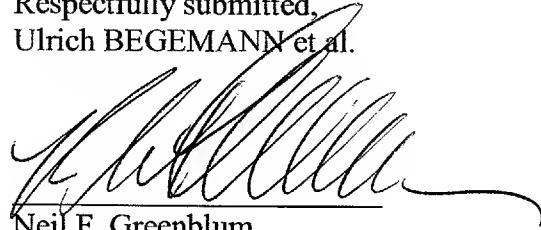
CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious Applicants' invention, as recited in claims 18 – 25, 27, 28 and 30 – 38. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
Ulrich BEGEMANN et al.



Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191